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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,089	05/06/2005	Jon Shipman	36692.00.0004	2450
7590 04/01/2008 Vedder Price Kaufman & Kammholz 222 North LaSalle Street Chicago, IL 60601				
EXAMINER HEWITT, JAMES M				
ART UNIT		PAPER NUMBER		
3679				
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04/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/534,089

**Applicant(s)**

SHIPMAN, JON

**Examiner**

JAMES M. HEWITT

**Art Unit**

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 4-5 is/are allowed.  
6) ☒ Claim(s) 1, 2 and 6-9 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 06 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/12/08 has been entered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of connection means (claims 7-9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (GB 2 288 860 A).

With respect to claim 1, Adams discloses a kit of parts for use in fabricating an air-conditioning system comprising: a tubing component (10) having at least two in-line sections (16A, 16B, 16C) with different external diameters; and a set of connection means (jubilee clips), each connection means having dimensions such that it may be joined to the tubing component at a respective section (e.g. 16A) and to enable connection to a pipe (11B) of substantially the same diameter as the respective section (16A).

With respect to claim 1, the phrase "connection means" is not considered to invoke 35 USC 112 6<sup>th</sup> paragraph as it does not meet the three-prong analysis as outlined in MPEP 2181.

With respect to claim 2, wherein each connection means comprises a locking ring. A jubilee clip is considered to be a locking ring.

With respect to claim 6, Adams discloses kit of parts for use in fabricating an air-conditioning system, comprising: a tubing component (10) having at least two in-line sections (16A, 16B, 16C) with different external diameters; and means for connecting (jubilee clip) any of the sections of the tubing component to a pipe (11B) of substantially the same diameter as the section (16A) of the tubing component.

A jubilee clip is considered to be a locking ring.

Claims 1-2 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Burchfield (GB 2 326 453 A).

With respect to claim 1 and with particular reference to Figures 5 and 6, Burchfield discloses a kit of parts comprising: a tubing component (second to the right in Figure 5) having at least two in-line sections with different external diameters; and a set of connection means (second to the left in Figure 5), each connection means having dimensions such that it may be joined to the tubing component at a respective

section and to enable connection to a pipe (leftmost in Figure 5) of substantially the same diameter as the respective section.

With respect to claim 2, wherein each connection means comprises a locking ring. Each section of the connector is considered to comprise a locking ring.

With respect to claim 6 and with particular reference to Figures 5 and 6, Birchfield discloses kit of parts comprising: a tubing component (second to the right in Figure 5) having at least two in-line sections with different external diameters; and means for connecting (second to the left in Figure 5) any of the sections of the tubing component to a pipe (leftmost pipe in Figure 5) of substantially the same diameter as the section of the tubing component.

With respect to claim 7, Burchfield discloses the kit of parts of claim 1 wherein each connection means is configured to join the tubing component at a respective section with a pipe of substantially the same diameter without having the pipe inserted into the relevant tubing component.

With respect to claim 8, Burchfield discloses kit of parts of claim 1 wherein each connection means includes a first portion that is dimensioned to be joined to the tubing component at a respective section and a second portion adapted to enable connection to a pipe of substantially the same diameter as the respective tubing section.

With respect to claim 9, Burchfield discloses kit of parts of claim 1 wherein each connection means includes at least two ends, one end dimensioned to receive a respective tubing component section and an opposite end dimensioned to receive a pipe within the connection means.

***Allowable Subject Matter***

Claims 4 and 5 are allowed.

***Response to Arguments***

Applicant's arguments filed 2/12/08 have been fully considered but they are not persuasive.

Applicant argues "In the 'Response to Arguments' section of the office action, Applicant respectfully submits that it appears that the claims are being interpreted to be inconsistent with the Specification and that the words 'substantially the same diameter' are not being given their ordinary meaning and instead is being given a meaning contrary to the Specification and understanding of one of ordinary skill in the art." and "It is respectfully submitted that one of ordinary skill in the art would not consider that a 1/4" diameter pipe and a 1/2" diameter pipe are substantially the same diameter since one can fit inside the other. This is what is taught in Adams. As such, if the rejection is maintained, Applicant respectfully requests documentary evidence supporting the position of the U.S. Patent Office since it appears to be inconsistent with the

Specification and with the knowledge of one of ordinary skill in the art. Applicant respectfully notes that an interpretation that is inconsistent with the Specification is not proper. Applicant also respectfully submits that the teachings of a reference cannot be overlooked in an effort to render a claim unpatentable.” In response, it is noted that claim 1 requires “each connection means being dimensioned...to enable connection to a pipe of substantially the same diameter as the respective section.”, and claim 6 requires “means for connecting any of the sections...to a pipe of substantially the same diameter as the section of the tubing component.” The “substantially the same diameter” recitation is within the context of an intended use or functional limitation. The pipe is not positively claimed as part of the invention. And it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Adams’ connection means are considered capable of connecting a section of the tubing component to a pipe of substantially the same diameter as the respective section. And it seems that Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although the specification mentions joining pipes of the same diameter, this is not claimed explicitly. Nor was “substantially the same diameter” defined in the specification to mean “the same diameter”.

Applicant then argues “In addition, Applicant respectfully notes that the claims also require that the connection means is dimensioned to be joined to the tube component at a respective section and to enable connection to a pipe of substantially

the same diameter. As such, the connection means is dimensioned to be joined to both the tubing component and the pipe. The office action cites a jubilee clip as allegedly corresponding to the claimed connection means. However, a jubilee clip as known in the art and as shown in the Adams reference is not adapted to connect to a pipe and a tube, but to the contrary, only makes contact with a single tube namely the exterior of hose 11 and as such, the Adams reference also fails to teach the claimed connection means." As indicated in the previous paragraph Adams' connection means (i.e. jubilee clip) are considered capable of connecting a section of the tubing component to a pipe of substantially the same diameter as the respective section. For instance, a jubilee clip can be used to join a tubing section that has a diameter of 3.25" to a pipe that has a diameter of 3.125".

Applicant also argues that Adams' jubilee clip is not equivalent to a locking ring. Examiner disagrees. As indicated in the 10/12/07 office action, a jubilee clip can reasonably be considered and arguably constitutes a locking ring as it comprises an annular adjustable ring that is configured for locking.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES M. HEWITT whose telephone number is (571)272-7084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James M Hewitt/  
Primary Examiner, Art Unit 3679